

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG W. BARNETT,
KAREN R. REISNER AND MARK BRAUNSTEIN

Appeal No. 2005-2686
Application No. 09/879,823

ON BRIEF

MAILED

AUG 09 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before JERRY SMITH, GROSS, and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider our decision of February 8, 2006 wherein we sustained the rejection of claims 47-62 as being based on an inadequate disclosure, and wherein we sustained the rejection of claims 47-62 as being anticipated by Von Kohorn under 35 U.S.C. § 102. Appellants also request that, in the alternative, we designate our decision a new ground of rejection under 37 CFR § 41.50(b) based on our reliance on different portions of Von Kohorn than were used by the examiner in sustaining the examiner's rejection.

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Appellants argue that the rejection of claim 61 under the first paragraph of 35 U.S.C. § 112 was improperly sustained because claim 61 does not recite the elements for which no support in the specification was found in the original decision [request, page 7].

We agree with appellants and regret the oversight. We vacate that portion of our decision which held that claim 61 failed to comply with the first paragraph of 35 U.S.C. § 112. Therefore, the examiner's rejection of claims 47-62 under the first paragraph of 35 U.S.C. § 112 is still sustained with respect to claims 47-60 and 62-67, but is not sustained with respect to claim 61.

Appellants argue that the Board acknowledged that the examiner did not rely on the best portions of Von Kohorn and that the Board relied on a different portion of Von Kohorn in sustaining the examiner's rejection. Appellants argue that the decision should be designated as a new ground of rejection so that appellants have a fair opportunity to respond to these new findings [request, pages 7-9].

Although a reference cited as prior art is considered to be cited in its entirety, the designation of a new ground of

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rejection is based on fundamental fairness to appellants. Since Von Kohorn is an extremely large reference with several different embodiments disclosed therein, we agree with appellants that they had a right in this case to rely on the specific portions of the reference cited by the examiner. Since we basically agreed with appellants that some portions of Von Kohorn relied on by the examiner did not support the examiner's findings, we agree with appellants that fundamental fairness requires that we designate our decision in this case with respect to the anticipation rejection as a new ground of rejection under 37 CFR § 41.50(b).

Appellants argue that the new portions of Von Kohorn relied on in the decision on appeal do not support the findings of anticipation as set forth in the decision [request, pages 10-17]. First, appellants argue that the portions of Von Kohorn cited in the Board's decision do not disclose "targeting." Appellants support this argument by citing a different portion of Von Kohorn than the portion cited in the Board's decision [request, pages 10-14].

We are not persuaded of error by this argument. First, appellants cite a portion of Von Kohorn which follows the statement "[i]n accordance with a further aspect of the

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invention" [column 99, line 18]. Thus, appellants are citing a portion of Von Kohorn which is a different embodiment than the one relied on in the Board decision. Second, the portion of Von Kohorn relied on by the Board specifically states that participants can designate areas of interest and receive coupons related to the area of interest. Therefore, these participants are targeted for receiving coupons in the area of interest. Only participants having designated this area of interest receive these coupons in this embodiment.

Appellants also argue that the decision fails to address the "monitoring redemption" element of the claimed invention. Appellants additionally argue that the recitations of dependent claims 51 and 56 are not met by Von Kohorn [request, pages 14-17].

These arguments were addressed to the extent that they were made in the briefs. Appellants are not permitted to have arguments considered in a request for rehearing that were not made in the briefs.

Appellants argue that our decision in this case conflicts with the decision in a related appeal [request, pages 17-18]. We regret that the decision in the related appeal was made before the Board had fully grasped all the teachings of Von Kohorn.

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Unfortunately, the Board in the related appeal relied on the same portions of Von Kohorn cited by the examiner that were found to be deficient. A subsequent review of Von Kohorn finds that Von Kohorn supports the rejection for reasons noted in the original decision in this case and for reasons discussed above.

Appellants argue that the Board has inconsistently interpreted the phrase "predetermined number of times" for purposes of finding anticipation under 35 U.S.C. § 102(b) and lack of written description under 35 U.S.C. § 112. Appellants assert that the Board failed to point to any express disclosure in Von Kohorn of limiting use of a coupon to a "predetermined number of times" [request, pages 18-20].

First, it is noted that the standards for support of a claimed invention under the first paragraph of 35 U.S.C. § 112 and for disclosure of the invention by the prior art are not the same. As was discussed in the original decision, appellants' specification does not provide support for the breadth of the phrase "predetermined number of times," but the phrase is met by the number one. Since the printed coupons in Von Kohorn can only be redeemed one time, Von Kohorn discloses the invention when given its broadest interpretation which is also consistent with

what appellants' specification supports. The interpretation of the phrase argued by appellants is not supported by appellants' specification.

Appellants argue that the Board improperly read the condition of fraud into the claimed invention for purposes of considering whether the phrase a "predetermined number of times" was supported by appellants' specification [request, pages 20-23]. We are not persuaded by this argument. The decision in this case simply dismissed appellants' proposed second meaning of the phrase a "predetermined number of times" because the specification teaches that a coupon can only be redeemed once as a measure to prevent fraud. The decision simply notes that the meaning of the phrase proposed by appellants would not perform the important function of fraud protection as taught by the disclosure.

In summary, we have granted appellants' request for rehearing to the extent that we have vacated our decision with respect to sustaining the rejection of claim 61 under 35 U.S.C. § 112, and that we have designated our sustaining of the rejection of all claims under 35 U.S.C. § 102(b) as a new ground of rejection under 37 CFR § 41.50(b). The request for rehearing is denied with respect to all other issues raised in the request.

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In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the

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affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING GRANTED IN-PART AND DENIED IN-PART
37 CFR § 41.50(b)

Jerry Smith

JERRY SMITH)
Administrative Patent Judge)

Anita Pelman Gross)
ANITA PELLMAN GROSS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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Stuart S. Levy)
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Ex parte CRAIG W. BARNETT,
KAREN R. REISNER and MARK BRAUNSTEIN

Appeal No. 2005-2686
Application No. 09/879,823

HEARD: JANUARY 11, 2006

Before JERRY SMITH, GROSS, and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 47-62, which constitute all the claims pending in this application.

The disclosed invention pertains to an on-line coupon distribution system. More particularly, the invention downloads coupon information from a host computer to a client computer where a paper coupon is printed by the client computer. One aspect of the claimed invention is that a target audience is

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determined for receiving coupons based on user preferences stored on the user's computers.

Representative claim 47 is reproduced as follows:

47. A method comprising:

 determining a target audience of one or more users of devices coupled to a network, wherein the target audience is determined based on one or more preferences of the users stored in the respective users' devices; and

 providing a coupon to the target audience determined, wherein each coupon may be used a predetermined number of times, wherein providing a coupon to the target audience further comprises:

 determining a subset of users of the network based on a preference profile;

 delivering one or more coupons to the subset of users; and

 monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times.

The examiner relies on the following reference:

Von Kohorn 5,227,874 July 13, 1993

Claims 47-62 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

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Claims 47-62 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Von Kohorn.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the prior art rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that appellants' specification fails to support the invention now being claimed. We are also of the view that the evidence relied upon by the examiner supports the examiner's prior art rejection. Accordingly, we affirm.

We consider first the examiner's rejection of the claims under the first paragraph of 35 U.S.C. § 112. With respect to independent claims 47, 52, 57, 61 and 62, the examiner objects to the phrases "wherein each coupon may be used a predetermined number of times" and "monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times" because the specification only supports a single use of each coupon, whereas the claim covers using the coupon a plurality of times. With respect to the same claims, the examiner also objects to the phrase "preferences of the users stored in the respective user's devices" because the specification does not support preferences or profiles being stored on the user's devices [answer, pages 3-4].

With respect to the examiner's first objection noted above, appellants argue that the claim language is supported by the specification as was agreed to by the examiner at a personal interview. No further discussion of this rejection is made in the main brief. The examiner disputes that the claim language was found acceptable in the noted interview. The examiner reasserts that the specification only supports the predetermined number being one [answer, page 7]. Appellants respond that

nothing in the specification dictates that the number of times must be one. Appellants also assert an interpretation of the claim language in which the predetermined number refers to the total number of coupons which can be redeemed by a plurality of users [reply brief, pages 2-3].

We agree with the examiner that the specification does not support the objected to phrases noted in the rejection. It appears that the objected to phrases are capable of two entirely different interpretations. The first interpretation is that each printed coupon given to one user can be used a predetermined number of times. This interpretation is the one accepted by the examiner and appears to be the interpretation initially argued by appellants. This interpretation is not supported by the specification because the specification, as argued by the examiner, suggests that each printed coupon is to be used only one time to avoid fraud. In the reply brief, appellants assert the second interpretation. This interpretation suggests that the predetermined number recited in the claims refers to the total number of coupons issued to all the targeted users. Although this interpretation might be consistent with the claim language, it appears to be completely unrelated to anything found in the

disclosure. That is, we can find nothing in appellants' specification to suggest that the total number of issued coupons is monitored to prevent fraud. Thus, this second interpretation appears to be an interpretation recently devised by appellants in an attempt to render these claims patentable. Given these two completely different interpretations of the claim language, we decline to accept an interpretation which lacks any support or recognition in the specification as filed. Therefore, we accept the interpretation used by the examiner, and apparently by appellants initially, and conclude that the claim language so interpreted is unsupported by the specification.

With respect to the examiner's second objection noted above, appellants argue that the specification supports the feature of storing preferences of a user (e.g., coupons that a user has viewed, selected, printed, etc.) on the user's computer [brief, pages 13-14]. The examiner responds that the target and profile information are disclosed as being stored at the central location for analysis. The examiner asserts that the user selection of coupons is not the same as user preferences, profile or adequate targeting information. Although the examiner acknowledges that demographic information is collected from the user, the examiner

argues that the information is only stored at the central location [answer, pages 7-12]. Appellants respond that selected coupon data is "preference data" and is stored at the user's device [reply brief, pages 4-6].

We agree with appellants that the specification supports the storage of user preferences on the user's device. The fact that some of the data stored at the central location is obtained from the user's device supports the claim language that one or more preferences of the users are stored in the respective users' devices. The fact that analysis of the data might occur at the central location does not alter the fact that the coupon information related to the user is stored at the user's device.

Since we agree with at least one of the examiner's objections to the claims under the first paragraph of 35 U.S.C. § 112, we will sustain the examiner's rejection of claims 47-62 for the reasons discussed above.

We now consider the rejection of claims 47-62 under 35 U.S.C. § 102(b) as being anticipated by Von Kohorn. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure

which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how the claimed invention is believed to be fully met by the disclosure of Von Kohorn [answer, pages 4-6]. With respect to independent claims 47, 52, 57, 61 and 62, appellants argue that Von Kohorn fails to disclose determining a target audience, providing a coupon to the target audience and determining a subset of users as claimed. Specifically, appellants argue that none of the passages of Von Kohorn cited by the examiner disclose these claim elements. Appellants note that the cited passages do not disclose storing user preferences on a dispenser unit so that they also fail to disclose determining a target audience based on these preferences. Finally, appellants argue that these passages are silent regarding enabling a coupon to be used a predetermined number of times [brief, pages 16-17].

The examiner responds that Von Kohorn discloses that the user enters information regarding items for which there is an interest in a future purchase at a sale or discounted price, and the dispenser alerts the user when the item is on sale or being offered at a discounted price. The examiner also notes that Von Kohorn stores user coupon selection information on the user device and that such coupon selections represent user desires. The examiner also responds that Von Kohorn discloses targeting an audience based on preferences as well as determining a subset of users based on preferences. Finally, the examiner responds that Von Kohorn discloses using a coupon a predetermined number of times wherein the predetermined number is one [answer, pages 12-22].

Appellants respond that none of the portions of Von Kohorn cited by the examiner show determining a target audience based on stored preferences. Appellants note that the consumer in Von Kohorn is not targeted, but instead, receives a listing of all coupons and discounts. Appellants note that viewing a broadcast program in Kohorn is not storing a user preference as claimed. Finally, appellants argue that Von Kohorn does not disclose

monitoring the redemption of coupons such that each coupon may be used a predetermined number of times [reply brief, pages 6-11].

We will sustain the examiner's rejection of independent claims 47, 52, 57, 61 and 62. Although the examiner may not have cited the best passages of Von Kohorn in support of the rejection, we agree with the examiner that the entirety of the Von Kohorn disclosure provides the evidence necessary to support the examiner's rejection. Specifically, we note that one of the many embodiments disclosed by Von Kohorn is an embodiment in which a user can select a product area of interest and, subsequently, receive an award in the form of a coupon allowing him to purchase a product in the area of interest [column 98, lines 41-44]. This embodiment suggests that the total audience is targeted into subsets based on the selection of a product area of interest made by the user. Thus, not only is a target audience for a given coupon determined, but the targeting is based on a selection made by the user which would be stored on the user's device. Note that these coupons are only sent to the targeted user which results in a higher rate of redemption of the coupons [id., lines 60-64]. With respect to the recitation that each coupon may be used a predetermined number of times, we agree

with the examiner that Von Kohorn clearly teaches that each coupon may be used only one time, such that the predetermined number is one.

With respect to dependent claims 48, 49, 53, 54, 58, and 59, appellants simply assert without any analysis that the passages of Von Kohorn cited by the examiner do not disclose a preference profile as claimed [brief, page 17]. The examiner cited a passage of Von Kohorn describing the dispensing of coupons targeted to a subset of the total audience [column 105, lines 16-23]. Since we agree with the examiner that the cited portion of Von Kohorn discloses that a preference profile is determined for respective users, and since appellants have not explained why the examiner's position is in error, we also sustain the examiner's rejection of claims 48, 49, 53, 54, 58 and 59.

With respect to dependent claims 50, 55 and 60, appellants simply assert without any analysis that the passages of Von Kohorn cited by the examiner do not disclose checking a coupon database to determine whether a particular coupon is valid [brief, page 17]. The examiner has pointed out how the redemption center in Von Kohorn matches validation codes recorded in order to verify a coupon's authenticity [answer, page 22].

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Since we agree with the examiner that Von Kohorn discloses a coupon database, and since appellants have not explained why the examiner's position is in error, we also sustain the examiner's rejection of claims 50, 55 and 60.

With respect to dependent claims 51 and 56, appellants simply assert that the passages of Von Kohorn cited by the examiner do not disclose serializing the coupons such that each coupon can be redeemed only once [brief, page 17]. The examiner has pointed out that Von Kohorn serializes coupons so that they can be redeemed only once [answer, page 22]. Since we agree with the examiner that Von Kohorn discloses the serializing of coupons [column 85, lines 20-21], and since appellants have not explained why the examiner's position is in error, we also sustain the examiner's rejection of claims 51 and 56.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 47-62 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

Jerry Smith

JERRY SMITH)
Administrative Patent Judge)

Anita Pellan Gross

ANITA PELLMAN GROSS) BOARD OF PATENT
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Stuart S. Levy

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